

REMARKS

Reconsideration of the present application and entry of the remarks are respectfully requested. Claims 1 to 41 are currently pending, and no claims have been amended.

The Office Action mailed November 2, 2004 addressed claims 1 to 41. Claims 1, 3, 4, 9 and 11 to 14 were rejected, and claims 2, 5 to 8, 10 and 15 to 41 were withdrawn from consideration.

Claims 1, 3, 4, 9, 11, 12 and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by Keller et al. (5,770,325). The Examiner stated that regarding claims 1, 3 and 4, Keller discloses a dimpled golf ball with indicia made from ink. The Examiner further stated that the ink jet printer and transfer medium are method steps and do not appear to further limit the final golf ball. The Examiner further stated that regarding claim 9, the golf ball includes a topcoat; regarding claim 11, the indicia may be applied on a primer; regarding claim 12, a primer coating inherently promotes adhesion; and regarding claim 14, the ink is a UV curable ink, and the ink is inherently cured once applied to the golf ball.

Applicants respectfully disagree with the Examiner. Keller discloses a UV curable ink for pad printing on a golf ball. Keller does not disclose or claim a golf ball having an indicia applied by ink jet printing. The UV curable ink of Keller is very different from the ink used with an ink jet printer. As stated in Applicants' specification, most UV curable inks are not even suitable for ink jet printing due to their properties (see, for example, page 8, lines 4 to 13).

Applicants respectfully disagree with the Examiner's assertion that "[t]he ink jet printer and transfer medium are method steps and do not appear to further limit the final golf ball." The ink jet printer and the ink composition adapted for ink jet printing influence the quality of the indicia on the golf ball, and therefore do limit the final golf ball quality.

Applicants respectfully disagree with the Examiner's assertion that a primer coating inherently promotes adhesion, and submit that a primer coating will not inherently promote adhesion. Depending on the type of primer coating used, adhesion may be promoted or the primer coating may make it even worse if the primer coating is not compatible with the ink composition.

Since Keller does not teach each and every element of Applicants' claim 1, Applicants respectfully submit that Keller does not anticipate Applicants' claim. Claims 3, 4, 9, 11, 12 and 14 depend or ultimately depend from claim 1 and are therefore also not anticipated by Keller. Applicants respectfully request that the Examiner reconsider and withdraw the rejections of claims

1, 3, 4, 9, 11, 12 and 14 as anticipated by Keller under 35 U.S.C. § 102(c).

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Keller in view of Hatch (5,817,735). The Examiner stated that Keller discloses the invention as disclosed above but fails to disclose the primer comprising magnesium silicate, but Hatch teaches a primer for a golf ball comprising magnesium silicate. The Examiner concluded that one of ordinary skill in the art would have included a magnesium silicate in the primer to enhance the color of the ball thereby producing better clarity of the indicia.

Applicants respectfully disagree with the Examiner and submit that the Examiner has not made out a *prima facie* case of obviousness. As previously discussed, Keller is deficient because it does not disclose Applicants' invention. Claim 13 depends from claims 1. The addition of another reference, Hatch, does not cure the deficiency of Keller.

For at least these reasons, Applicants respectfully submit that claim 13 is not obvious over Keller in view of Hatch. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 13 under 35 U.S.C. § 103(a).

Claims 1, 3, 4, 9 and 11 to 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hatch et al. (5,817,735) in view of Mello et al. (5,778,793). The Examiner stated that regarding claims 1, 3 and 4, Hatch discloses a primer for a golf ball, and the golf ball includes ink indicia stamped or painted on the surface. The Examiner further stated that the ink jet printer and transfer medium are method steps and do not appear to further limit the final golf ball. The Examiner further stated that Hatch does not disclose a dimpled golf ball, but Mellow teaches a dimpled golf ball comprising indicia on the surface. The Examiner further stated that regarding claim 9, Hatch discloses that the golf ball includes a topcoat; regarding claims 11 and 12, Hatch discloses the golf ball includes a primer coat, and a primer is well known for promoting adhesion; regarding claim 13, Hatch discloses the primer includes magnesium silicate; and regarding claim 14, Mello teaches UV curable ink for indicia. The Examiner concluded that one of ordinary skill in the art would have modified Hatch in view of Mello by implementing a UV curable ink to decrease curing time.

Applicants respectfully disagree with the Examiner and submit that the Examiner has not made out a *prima facie* case of obviousness. Hatch discloses a water-based primer, and one of the uses of the primer is on a golf ball cover. Contrary to the assertions of the Examiner, Hatch does not disclose a golf ball having an indicia on its dimpled surface.

Mello discloses shaded logos for golf balls and methods of making plates for printing the shaded logos. Mello does not disclose printing indicia on a golf ball using an ink jet printer. As previously stated, Applicants respectfully disagree with the Examiner's assertions that the ink jet printer and transfer medium do not limit the final golf ball.

Applicants respectfully submit that neither Hatch nor Mello, alone or in combination, disclose Applicants' claim 1 because neither reference discloses a golf ball having an indicia applied by ink jet printing with an ink composition suitable for ink jet printing. Claims 3, 4, 9 and 11 to 14 depend or ultimately depend from claim 1.

For at least these reasons, Applicants respectfully submit that claims 1, 3, 4, 9 and 11 to 14 are not obvious over Hatch in view of Mello. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 1, 3, 4, 9 and 11 to 14 under 35 U.S.C. § 103(a).

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicants respectfully request reconsideration of the rejected claims, claims 1, 3, 4, 9 and 11 to 14. Applicants respectfully request allowance of claims 1, 3, 4, 9 and 11 to 14, the claims currently pending.

Respectfully submitted,

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